

### REMARKS

Applicants thank the Examiner for the consideration given the present application. Claims 55-79 are pending. Claims 1-54 were cancelled previously. No new claims have been added.

#### *The Obviousness-type Double Patenting Rejection*

Claims 55-79 are rejected under the judicially created doctrine of obviousness-type double patenting. Specifically, Claims 55-79 are rejected as being unpatentable over Claims 1-49 of U.S. Patent No. 6,726,947, Claims 1-26 of U.S. Patent No. 6,808,731 and Claims 1-19 of U.S. Patent No. 6,759,072, and are provisionally rejected for being unpatentable over co-pending Application No. 10/833,757. In a sincere effort to advance the prosecution of this case, included with this response is a Terminal Disclaimer, disclaiming the terminal part of the statutory term of the above-referenced patent, as well as any patent granted on the above-identified application, which would extend beyond the expiration date of the full statutory term defined in 35 U.S.C. §154 to §156 and §173 as presently shortened by any terminal disclaimer of U.S. Patent Nos. 6,726,947, 6,808,731 and 6,759,072, and co-pending Application No. 10/833,757. In submitting this Terminal Disclaimer, Applicants state for the record that this Disclaimer is not an admission of obviousness in view of the cited U.S. applications. *Quad Envtl. Corp. v. Union San. Dist.*, 20 USPQ2d 1392 (Fed. Cir. 1991). Accordingly, it is respectfully requested that the obviousness-type double patenting rejections be withdrawn.

#### *The Rejection under 35 U.S.C. §102*

The Examiner has rejected Claims 55, 63 and 64 under 35 U.S.C. § 102 as allegedly being anticipated by Jefferson Jr. et al., U.S. Patent No. 5,980,965 (hereafter "Jefferson"). Specifically, the Examiner alleges that Jefferson discloses "a process for preparing a brewed coffee beverage wherein the coffee is brewed in a brewer, stored in the same (in the presence of coffee grounds) for a time including 10 minutes from the onset of brewing, releasing the coffee through a filter after said storage and dispensing same into a coffee receptacle." See Office Action of September 8, 2005, pages 4-5, citing Abstract; Claim 17; Col. 4, lines 53-65. Applicants respectfully traverse this rejection.

Under 35 U.S.C. § 102, a claim is anticipated only if each and every claim element is found, either expressly or inherently disclosed, in a single prior art reference. See *Verdegaal Bras. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987). Although this disclosure requirement presupposes the knowledge of one skilled in the art of the claimed invention, that presumed knowledge does not grant a license to read into the prior art reference teachings that are not there. See *Motorola, Inc. v. Interdigital Tech. Corp.*, 121 F.3d 1461, 43 USPQ2d 1481, 1490 (Fed. Cir. 1997). Additionally, there must be no difference between what is claimed and what is disclosed in the applied reference. See *Scripps v. Genetech Inc.*, 18 USPQ2d 1001, 1010 (Fed. Cir. 1991). Moreover, it is incumbent on the Examiner to identify wherein each and every facet of the claimed invention is disclosed in the applied reference. *Ex parte Levy*, 17 USPQ2d 1461, 1462 (BPAI 1990).

Applicants respectfully assert that Jefferson does not anticipate the present invention under §102 because Jefferson does not teach a process for brewing coffee beverage that involves storing the coffee extract in contact with the grounds before filtering. More particularly, Jefferson is concerned with obtaining a constant brew time for a coffee extract regardless of the volume of coffee extract being prepared in an effort to produce a consistently flavored pot of coffee. Jefferson indicates that “[c]ontact between a portion of the heated water and the coffee grounds is maintained for approximately the selected brew time to form a brewed beverage.” (Emphasis added). See Col. 3, lines 10-12. Applicants respectfully assert that contrary to the Examiner’s position that Jefferson teaches brewing a coffee extract and storing the extract in contact with the grounds, what Jefferson in fact discloses is contacting heated water with coffee grounds during the brew cycle. Even more specifically, Jefferson stipulates that it is “at least a portion of the heated water” that contacts the coffee grounds, simply meaning that the heated water should pass through the coffee grounds at a consistent rate throughout the duration of the brew time, regardless of volume. This notion is further supported at Col. 3, lines 24-26 where the Jefferson invention is described as providing that the “flow of the water out of the brewing chamber is controlled so that the ground coffee is exposed to heated water in the brewing chamber for the desired brewing time.” Thus, in order for the brew cycle to take the entire brew time selected by the consumer, the heated water should consistently pass through, and thereby contact, the coffee grounds to produce a coffee extract, which is then immediately passed through the brewer and into a receptacle.

Moreover, there is no teaching in Jefferson of storing the coffee extract in contact with the coffee grounds for any amount of time after brewing the extract. In other words, Jefferson does not even suggest the use of delayed filtration in the first instance. Indeed, Jefferson teaches

that "undesirable compounds are normally released into brewed coffee when the hot water remains in contact with the ground coffee beans for relatively long duration." See Col. 1, lines 18-23. This statement supports the notion that the Jefferson invention is concerned with quickly and consistently passing the heated water through the coffee grounds, immediately through a filter or filters, and out of the machine, being sure that at least some portion of the heated water is being passed through the coffee grounds at all times during the brew time. For example, see Col. 7, lines 38-52 of Jefferson, which explains the inventive brewing process using two different volumes of water and indicates that the brewed extract exits the brewer after filtration. This is in contrast to the present invention which, according to Claim 55, requires that the brewed coffee extract be stored "in the brewer in contact with the coffee grounds for from about 5 minutes to about 48 hours after onset of brewing the extract." Therefore, for this additional reason, Applicants respectfully assert that Jefferson does not anticipate the present invention under §102.

Thus, for these reasons, it is respectfully requested that the Examiner withdraw the rejection under 35 U.S.C. §102.

*The Rejection under 35 U.S.C. § 103*

The Examiner has rejected Claims 56-79 under 35 U.S.C. § 103 as being unpatentable over several references. In general, the Examiner relies on Jefferson alone and taken together with Anson, U.S. Patent No. 5584229 (herein "Anson"), with Cheng, U.S. Patent No. 6,319,537 (herein "Cheng"), Kino et al., U.S. Patent No. 6,231,907 (herein "Kino"), Borland et al., U.S. Patent 6,352,736 (herein "Borland") and GB 2111377 (herein "GB"), to obviate the present claims.

More specifically, the Examiner relies on Jefferson to generally teach a process for preparing a brewed coffee beverage as previously described. The Examiner admits that "Jefferson is silent regarding diluting the coffee extract after filtering but before dispensing." However, Anson is relied on to teach diluting beverages as a way to adjust temperature and thus, the Examiner concludes that it would have been obvious to dilute the coffee of Jefferson to control the temperature of the beverage. The Examiner further relies on Cheng to remedy this deficiency, stating that Cheng teaches diluting a coffee concentrate. Additionally, the Examiner states that although Cheng teaches "packaging a brewed coffee concentrate for up to a large period of time" there is no teaching of diluting 5 minutes to 48 hours after filtering. In spite of this deficiency, the Examiner concludes that this would have been obvious. Based on Kino, it is further concluded that it would have been obvious to store the coffee extract in contact with the grounds sealed from oxygen. Finally, Borland is relied on to teach brew solids content of the coffee

extract while GB is relied on to teach filtering after 15 and 30 minutes. Applicants respectfully traverse these rejections.

Applicants respectfully submit that, a reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention. See W.L. Gore and Assoc., Inc. For all of the reasons stated previously in the discussion under § 102, Jefferson teaches away from the present invention. In particular, Jefferson teaches that “undesirable compounds are normally released into brewed coffee when the hot water remains in contact with the ground coffee beans for relatively long duration.” See Col. 1, lines 18-23. This statement teaches away from the present claims, which indicate that the coffee extract, which is arguably comprised in part by hot water, should be stored in contact with the coffee grounds for from about 5 minutes to about 48 hours after the onset of brewing the extract.” See Claim 55, from which all other claims depend. Therefore, Applicants respectfully assert that Jefferson teaches away from the present invention, and for this reason alone, the present invention is not obviated.

In addition, the Examiner bears the burden of factually supporting any prima facie conclusion of obviousness. In determining the differences between the cited art and the claims, the question is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious. See Stratoflex, Inc. v. Aeroquip Corp., 713 F.2d 1530 (Fe. Cir. 1983). Distilling the invention down to the “gist” or “thrust” of an invention disregards the requirement of analyzing the subject matter “as a whole.” See W.L. Gore & Assoc., Inc. v. Garlock, Inc., 721 F.2d 1540 (Fed. Cir. 1983). Inventors of unobvious compositions, such as those of the present invention, enjoy a *presumption* of non-obviousness, which must then be overcome by the Examiner establishing a case of prima facie obviousness by the appropriate standard. If the Examiner does not prove a prima facie case of unpatentability, then without more, the Applicant is entitled to grant of the patent. See In re Oetiker, 977 F.2d 1443.

To establish a prima facie case of obviousness under 35 U.S.C. §103, the Examiner must meet three basic criteria. First, there must be some suggestion or motivation, either in the reference itself, or in the knowledge generally available to one of ordinary skill in the art, to modify the reference. Second, there must be a reasonable expectation of success. Finally, the cited reference must teach or suggest *all* the claim limitations. See, for example, In re Vaack, 947 F.2d 488 (Fed. Cir. 1991). Applicants respectfully assert that the Office Action fails to establish the second and third criteria, and thus, fails to make a prima facie case of obviousness under 35 U.S.C. § 103.

First, there is no likelihood success. For the reasons discussed previously in regards to the teachings of Jefferson, Applicants respectfully assert that Jefferson provides no likelihood of success. Moreover, the additional cited references do nothing to remedy the deficiencies of Jefferson. In particular, none of the cited references teaches storing a brewed coffee extract in contact with coffee grounds for any length of time. Therefore, it is respectfully asserted that Jefferson, both alone and when taken together with the additional references, fails to provide a likelihood of success and thus, for this reason alone, fails to establish a prima facie case of obviousness.

Additionally, there is no teaching of all the claim limitations. Again, none of the references, either alone or in combination, teach storing a brewed coffee extract in contact with coffee grounds in the first instance, as claimed in the present Claim 55, from which all other claims herein ultimately depend. Indeed, as explained previously, Jefferson actually teaches away from this practice. Because the references fail to teach all of the present claim limitations, Applicants respectfully assert that for this additional reason, a prima facie case of obviousness has not been established.

For these additional reasons, it is respectfully asserted that the present claims are not obvious in view of the cited references, and it is therefore respectfully requested that the rejection under 35 U.S.C. §103 be withdrawn.

#### CONCLUSION

In view of the foregoing, it is respectfully submitted that the Examiner's rejections under 35 U.S.C. §§ 102 and 103, as well as the double patenting rejection, have all been overcome. Withdrawal of these rejections is respectfully requested.

Respectfully submitted,

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